

REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed February 9, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

I. Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-3, 5, 7-15, and 17-20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kennedy, et al. ("Kennedy," U.S. Pat. 6,651,217) in view of Goheen (U.S. Pat. No. 5,724,520) further in view of Berger, et al. ("Berger," U.S. Pat. No. 6,112,986). Applicant respectfully traverses this rejection.

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). The Manual of Patent Examining Procedure (MPEP) section 2143 discusses the requirements of a *prima facie* case for obviousness. That section provides as follows:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and reasonable expectation of success must be found in the prior art, and not based on applicant's disclosure.

In the present case, there is no suggestion or motivation in the prior art to modify the Kennedy reference in the manner suggested in the Office Action. In the following, Applicant discusses the applied references and their relevance to Applicant's claims.

A. The Kennedy Reference

Kennedy discloses a system with which forms can be automatically completed. When a user first populates a form presented to the user with a web site, the information provided by the user is extracted and used to create a profile for the user that can be used to automatically complete subsequently-displayed forms that are encountered at other web sites. Kennedy, Abstract, column 6, lines 19-23.

B. The Goheen Reference

Goheen discloses a system for issuing electronic authorization and validation for scheduled activities, such as airline reservations. Goheen, Abstract. As is described by Goheen, when an airline passenger makes a reservation, the passenger is issued an identification card that stores passenger information. Goheen, column 2, lines 51-54. When the passenger arrives at the airport terminal, the passenger swipes the card at an ATM. Goheen, column 2, lines 61-66. Upon reading the passenger information stored on the card, the ATM displays various information to the user, such as the gate and time of departure. Goheen, column 3, lines 4-7. In addition, the ATM prints out a "print-out tape" that comprises the same information. Goheen, column 3, lines 9-11; column 7, lines 40-44. The passenger then proceeds to his or her gate.

Once arriving at the gate, the passenger provides the identification card to a flight attendant, who swipes the card through a magnetic card reader to confirm that the passenger has a reservation and is authorized to board the aircraft. Goheen, column 3, lines 20-25. Goheen says nothing whatsoever about filling out forms.

C. The Berger Reference

Berger discloses a system for putting user information on a credit card-like medium that can be scanned at an office or hospital. Berger, Abstract.

D. Applicant's Claims

Applicant claims methods, systems, and apparatus for completing forms. For example, independent claim 1 provides as follows:

1. A method for completing forms, comprising:
reading a user data card to determine a network location at which user information to be added to a form is stored;
retrieving the user information from the network location;
configuring the user information for merging with the form;
merging the user information into the form by populating form data fields with pieces of the user information; and
printing a hard copy form that contains at least a portion of the user information.

As is described above, Kennedy discloses a system for automatically completing forms. It is there, however, where the similarities between Kennedy's system and Applicant's claimed methods, systems, and apparatus ends. Specifically, as is acknowledged in the Office Action, Kennedy fails to disclose or suggest either of

“reading a user data card to determine a network location at which user information to be added to a form is stored” and “printing a hard copy form that contains at least a portion of the user information”.

To account for these shortcomings, the Office Action relies upon the teachings of Goheen. As an initial matter, the combination of Goheen is questionable since, as stated above, Kennedy teaches a system for automatically completing forms on web sites, and Goheen teaches a system for enabling airline passengers to more quickly and easily board their aircraft. Again, the motivation or suggestion to modify a reference, such as the Kennedy reference, must be found in the art. Given the lack of a suggestion or motivation contained in the prior art for the proposed modification, it appears clear that the only suggestion or motivation comes from Applicant’s own disclosure. As is well established in the law, such hindsight to the Applicant’s own disclosure is *per se* improper. *See Crown Operations International, Ltd. v. Solutia, Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002) (a determination of obviousness cannot be based on a hindsight combination of components selectively culled from the prior art to fit the parameters of the invention).

With specific regard to the limitations of Applicant’s claims, a person having ordinary skill in the art would not be motivated from the disclosures of the Kennedy reference or the Goheen reference to incorporate “reading a user data card to determine a network location at which user information to be added to a form is stored”. As is mentioned in the foregoing, the Kennedy system is used in the Internet environment. The user’s information is extracted from a form that a user completes on one web site, and may be used to fill in another form that the user wishes to complete on another web site. As is described by Kennedy, “forms containing similar field labels can be automatically populated at the touch of a button.”

Given the above environment, it is unclear why a person having ordinary skill in the art would be motivated to add a card reader, such as that of Goheen's ATM, to the Kennedy system. Specifically, such an extravagance is simply not necessary, and would significantly add to the user's equipment expense given that, if a card is to be read, the user would need to add a card reader to his or her computer system. Because the user can, with Kennedy's system, simply select on onscreen button to populate fields of a form, a person having ordinary skill in the art would not be motivated to add an identification card and card reader into the operation of Kennedy's system. In fact, such a person would be motivated away from such a modification. As is well established in the law, "[t]here is no suggestion to combine . . . if a reference teaches away from its combination with another source . . . A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant . . ." *Tec Air, Inc. v. Denso Manufacturing Michigan Inc.*, 192 F.3d 1353, 52 USPQ2d 1294 (Fed. Cir. 1999).

Next, regarding the limitation "printing a hard copy form that contains at least a portion of the user information", the inferences drawn in the Office Action are similarly unwarranted. Again, Kennedy describes a system in which forms of web sites can be automatically completed, for example to complete an online purchase (see Kennedy, column 1, lines 20-23). Given that no hard copy of the form is required from the user (the user information is received through the web form), there is simply no reason to add the action of "printing a hard copy form that contains at least a portion of the user information" to Kennedy's described process. Indeed, the information that would be printed in such a case would not be information that the

user would like to have a copy of (such as information about the order he or she has placed), but instead would be information that the user already knows, such as the user's name, address, and credit card information. It is for this reason that Kennedy is silent as to printing out a form: to do so would serve no purpose for the user.

As a further matter, the combination of Kennedy and Goheen is troubling because of the distinct problems that are being solved. Again, Kennedy describes populating forms on web sites in order to place online orders, while Goheen describes facilitating airline check in and aircraft boarding. There is simply no reason why a person having ordinary skill in the art would think to incorporate Goheen's processes into Kennedy's system. This is particularly true given that Goheen's processes are used to confirm a user's authorization to do something, and not to provide any information in a form. Given the disparate purposes of the two systems, combination is just not warranted.

Finally, in regard to the Berger reference, the Office Action presumably cites Berger to support the combination of the features of Goheen's system with the Kennedy system. Although the Berger reference concerns providing information, Berger's teachings do not overcome the problems with combining the features of Goheen's system with Kennedy's system. Specifically, nothing in the Berger disclosure overcomes the fact that a person having ordinary skill in the art would not be motivated to add use of an identification card and card reader to Kennedy's system, or printing out information for a user of Kennedy's system. For at least these reasons, the rejection fails to make a *prima facie* case of Applicant's claim 1, or the claims the depend therefrom.

Turning to independent claim 9, the rejection is similarly deficient. Specifically, the rejection fails to render obvious "means for reading location information from a user data card" or "means for printing a hard copy form that contains at least a portion

of the user information". Claims 9-13 are allowable over the applied references for at least that reason.

Regarding independent claim 14, the Kennedy, the Goheen, and the Berger references do not concern a "printing device". Contrary to that alleged in the Office Action, Kennedy does not mention a printing device. Specifically, column 5, line 42 and column 28 are silent as to a printing device. Regarding the Goheen reference, Goheen does mention that Goheen's terminal ATM can print a "print-out tape," but one having ordinary skill in the art would hardly consider Goheen's ATM to be a "printing device," particularly in view of the definition that is provided by the Applicant. Berger similarly fails to describe a printing device. Accordingly, as an initial matter, the applied references fail to even identify the device that Applicant is explicitly claiming. That the recitation of the "printing device" appears in the preamble does not change this fact. Moreover, Applicant has amended claim 14 to give life and meaning to the term "printing device".

Turning to the various other limitations of claim 14, Applicant notes that the references do not render obvious a printing device that includes a "card reader". There is simply no support for the position that the references teach that feature. Similarly, there is no support for the position that references teach a printing device that includes a "network interface device that is adapted to retrieve user information from a network location identified in the location information". Similarly, the references fail to teach a printing device that includes a memory that "stores forms" or comprises a "form generation module stored in the printing device memory that merges the user information with a form stored in the device memory for the purpose of printing a hard copy form that is at least partially completed". Simply stated, the

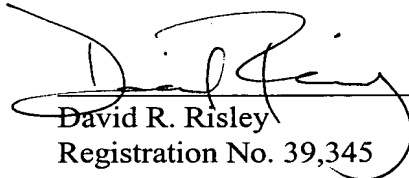
references do not describe a printing device, and therefore cannot render obvious the limitations of Applicant's claim 14.

In summary, it is Applicant's position that a *prima facie* for obviousness has not been made against Applicant's claims. Therefore, it is respectfully submitted that each of these claims is patentable over the applied references and that the rejection of these claims should be withdrawn.

CONCLUSION

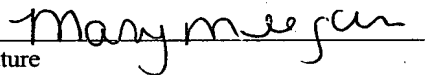
Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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4-28-05


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